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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,086	06/12/2000	Richard Marc Libman	2176.0010002	6844

7590 07/29/2003

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EXAMINER

ALVAREZ, RAQUEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 07/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application N .

09/592,086

Applicant(s)

LIBMAN, RICHARD MARC

Examiner

Raquel Alvarez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-158 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-158 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

1. This communication is in response to communication filed on 5/15/2003. Claims 129-159 have been added.

#### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-158 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munsil et al. (5,761,650, hereinafter Munsil) in view of Ryan (5,673,402 hereinafter Ryan).

With respect to claims 1-30, 32-93 and 95-134, 139-158, Munsil teaches a method for automatically preparing a client communication pertaining to a product for a client (see figures). Producing a format for the client communication wherein the communication format includes a variable portion (i.e. the bill contains an allocated space for inserts)(see figure 6); inputting into a computer-accessible storage medium variable information other than the client identification (i.e. messages are defined and stored in a computer's memory)(see figure 7); inputting into the storage medium decision information (i.e. criteria for defining and including messages and inserts in the bill are stored)(see figure 7); using the decision information to select a subset of the variable information for inclusion in a variable portion of the client communication

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corresponding to the variable portion of the client communication format ( see figure 7); and generating the client communication according to the communication format, the generating step including inserting the subset of variable information into the variable portion of the client communication corresponding to the variable portion of the client communication format(i.e. the qualified message is inserted into the bill according to the formatting rules that fit into the bill)(see figures 7).

Munsil does not specifically teach that the client communication pertains to a financial product. The billing system and method of Munsil pertains to a cable television providers. Ryan teaches that the communication pertains to a financial product (in Munsil (Figures 27B and 29-31). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the communication to be for financial products and services because it would provide the information needed to tailor the additional products to the client's needs (in Ryan, col. 5, lines 17-22).

With respect to claims 31 and 94, the claims further recite selectively placing at least some content in blank spaces of said communication. Official notice is taken that it old and well known to selectively place blank spaces in a communication. For example, certain text books contained blank spaces that are used for future modification or changes. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included selectively placing at least some content in blank spaces of said communication in order to achieve the above mentioned advantages.

Claims 135-138 additional claim delivering and communicating the information via Internet, data file and voice response which are all old and well known in the computer arts. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included delivering the information using Internet, data file and voice response in order to provide the user with various choices of implementation.

### **Response to Amendment**

3. The affidavit filed on 8/28/2002 under 37 CFR 1.131 has been considered but is ineffective to overcome the Munsil reference. The conception of the invention was proven by exhibits 1-9 nevertheless the reduction to practice of each one of the claimed invention is not persuasive by the exhibits. Exhibits 1-2 and 4-9 show flow charts and screen printouts of the conception of the claim elements but do not show an actual reduction to practice, the invention must have been sufficiently tested to demonstrate

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that it will work for its intended purpose, but it need not be in a commercially satisfactory stage of development. If a device is so simple, and its purpose and efficacy so obvious, construction alone is sufficient to demonstrate workability. *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853, 860, 226 USPQ 402, 407 (Fed. Cir. 1985).

For additional cases pertaining to the requirements necessary to establish actual reduction to practice see *DSL Dynamic Sciences, Ltd. v. Union Switch & Signal, Inc.*, 928 F.2d 1122, 1126, 18 USPQ2d 1152, 1155 (Fed. Cir. 1991) (“events occurring after an alleged actual reduction to practice can call into question whether reduction to practice has in fact occurred”); *Corona v. Dovan*, 273 U.S. 692, 1928 C.D. 252 (1928) (“A process is reduced to practice when it is successfully performed. A machine is reduced to practice when it is assembled, adjusted and used. A manufacture [i.e., article of manufacture] is reduced to practice when it is completely manufactured. A composition of matter is reduced to practice when it is completely composed.” 1928 C.D. at 262-263 (emphasis added).); *Fitzgerald v. Arbib*, 268 F.2d 763, 765-66, 122 USPQ 530, 531-32 (CCPA 1959) (“the reduction to practice of a three-dimensional design invention 531-32 (CCPA 1959) requires the production of an article embodying that design” in “other than a mere drawing”).

Exhibit 3 shows pseudo codes. Pseudo codes are ways to show reduction to practice of some of the elements of the claimed invention but it doesn't show all the elements of the claimed invention like for example the claimed limitation “the communication having a communication format, wherein said communication format comprises at least one portion that accommodates the variable information, the

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generating step including incorporating the variable information into at least one portion of the communication” is not shown.

An issue of public use or on sale activity has been raised in this application (figure 9). In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows: the date that the invention became commercialized (public use or on sale information in this country of the claimed invention).

Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

#### **Conclusion**

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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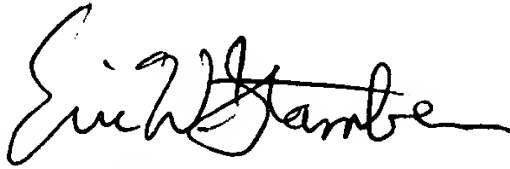
**Point of contact**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9326 for regular communications and (703)872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

R.A.  
July 25, 2003

  
ERIC W. STAMBER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600